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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,825	11/24/2003	Craig L. Reding	03-1025	5353
32127	7590	08/14/2007		
VERIZON PATENT MANAGEMENT GROUP 1515 N. COURTHOUSE ROAD, SUITE 500 ARLINGTON, VA 22201-2909			EXAMINER PHAN, HUY Q	
			ART UNIT 2617	PAPER NUMBER
			NOTIFICATION DATE 08/14/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/720,825	<b>Applicant(s)</b> REDING ET AL.	
	<b>Examiner</b> Huy Q. Phan	<b>Art Unit</b> 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-7,9,10,12,13,16 and 17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7,9,10,12,13,16 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This Office Action is in response to Amendment filed on date: 07/03/2007.  
Claims 1-7, 9, 10, 12, 13, 16, and 17 are still pending.

### ***Response to Arguments***

2. Applicant's arguments, see REMARKS, have been fully considered but they are not persuasive.

a) Applicant argued the legal principle of establishing a prima facie case of obviousness or/and more specifically that "one skilled in the art at the time of Applicants' invention would not have been motivated to incorporate this alleged teaching of PACKHAM et al. into the KARVE system, absent impermissible hindsight". The examiner respectfully disagrees with applicant's argument. The first criteria of the prior art references teaching or suggesting all the claim limitations was also met because the combination of Karve and Packham disclose every claimed limitation of independent claims as shown in previous rejection. The second criteria of a reasonable expectation of success was met since both references are from a similar field of endeavor such particularly as a method for forwarding SMS in the wireless communication system, and the combination of the two references would not be in opposition to either references' functions and operations thus resulting a reasonable expectation of success. The third criteria of motivation was met by providing a motivation from the secondary reference, Packham, which is to allow the user to "turn their mobile phone(s) off in areas where

that is necessary (such as in testing environments or hospitals) and still be able to have access to their messages. It also allows people to read their text messages received via email, for example on a home computer, which would possibly cause less disruption to their working day" (see [0019]-[0022]). Consequently, a prima facie case of obviousness under 35 U.S.C. 103 has been established.

b) Applicant argued that "Applicants submit that one skilled in the art would not reasonably look to incorporate PACKHAM et al.'s alleged disclosure of an HLR that stores forwarding information and a SMS/GMSC that forwards text messages intended for a first device to a second device into the KARVE system since the KARVE system is directed to actions performed by a cellular device (the first device). If one were to incorporate PACKHAM et al.'s HLR and SMS/GMSC into the KARVE system, this combination would obviate the need for the KARVE invention since the forwarded destination of the text message is identified prior to reaching the first device (KARVE's cellular device). The examiner respectfully disagrees. Karve clearly discloses that Karve's system is the same as Packham's system described as "SMS is a store and forward service. That is, short messages are not sent directly from sender to recipient, but always via an SMS Center. Each mobile telephone network that supports SMS must have at least one messaging center to handle and manage the short messages" (see [0007]). But, Karve does not particularly show instead of the first device for receiving the SMS message, thus, there is a need for applying the teaching of Packham that instead of the first device for receiving the SMS message (fig. 1 and [0019]-[0022]) in order for people to read their text messages received via email, for example on a

Art Unit: 2617

home computer, which would possibly cause less disruption to their working day" (see [0019]-[0022]).

c) Applicant argued that "formatted message to an e-mail address, as recited in claim 3. Sending an e-mail address, as disclosed by GOPINATH et al., is not equivalent to sending a formatted message to an e-mail address, as recited in claim 3". The examiner respectfully disagrees. As proved, Karve and Packham discloses the method of claim 1 or/and particularly that Karve ([0008]) and Packham ([0022]) suggest sending the formatted message to a personal computer and the user is able to retrieve the message. But, Karve and Packham do not expressly teach wherein sending the formatted message comprises sending the formatted message to an e-mail address. However in analogous art, Gopinath shows specifically that "a user may instruct through his SM that his contact email be sent to the recipient of the SM by just typing the keyword 'myemail' in his SM" (see [0054]-[0069]). Thus Gopinath discloses sending a SMS to an e-mail address. Consequently, combination of Karve, Packham and Gopinath disclose the claimed limitation of wherein sending the formatted message comprises sending the formatted message to an e-mail address.

With all the reasons stated above, the rejection is deemed proper and still stands.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2617

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

I) Claims 1, 2, 6, 9, 10, 12, 13, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karve (US-2002/0137530; previously cited) in view of Packham (US-2003/0055906).

Regarding claim 1, Karve discloses a method for providing SMS messages (fig. 3 and its description) to a receiving party (owner of telephone 10, [0029]) associated, able to communicate, with a plurality of devices (interpreted as "forwarding a received short message from the telephone 10 to another device or telephone" see [0029]), the method comprising:

receiving a SMS message for a first device ("telephone 10") of the plurality of devices ([0028]-[0029]);

identifying a second device of the plurality of devices as a preferred device ("a predefined number" [0032]-[0035]) for receiving the SMS message based on information stored by the receiving party ([0032]-[0035]);

formatting the SMS message according to characteristics of the preferred device [0028]; and

sending the formatted message to the preferred device ([0008]-[0010] and [0032]-[0035]).

But, Karve does not particularly show instead of the first device for receiving the SMS message. However in analogous art, Packham teaches instead of the first device for receiving the SMS message (fig. 1 and [0019]-[0022]). Since, Karve and Packham

Art Unit: 2617

are related to a method for transmitting SMS message in a communication system; therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Karve as taught by Packham in order to allow the user to "turn their mobile phone(s) off in areas where that is necessary (such as in testing environments or hospitals) and still be able to have access to their messages. It also allows people to read their text messages received via email, for example on a home computer, which would possibly cause less disruption to their working day" (see [0019]-[0022]).

Regarding claim 2, Karve further discloses the method of claim 1, wherein sending the formatted message comprises sending the formatted message to a SMS-capable device ([0008] and [0028]).

Regarding claim 6, Karve further discloses the method of claim 1, wherein sending the formatted message comprises sending the formatted message to digital companion client software (described as "the appropriate programming at the SMS center or by allowing the user to define forwarding address lists stored at the SMS center" see [0033]).

Regarding claim 9, Karve discloses an apparatus (fig. 2 and description) for providing SMS messages to a user (owner of telephone 10, [0029]) associated, able to communicate, with a plurality of devices (interpreted as "forwarding a received short

message from the telephone 10 to another device or telephone" see [0029]),  
comprising:

a database ("a memory at the SMS center" see [0033]) for storing information identifying each device of the plurality of devices (described as "identifying a pointer to a multiple destination address stored in a memory at the SMS center" see [0033]) and identifying a first device of the plurality of devices as a preferred device (described as "with the appropriate programming at the SMS center or by allowing the user to define forwarding address lists stored at the SMS center" see [0033]);

a gateway server ("SMS center" see [0028]) for receiving a SMS message identifying a second device ("telephone 10", see [0029]) of the plurality of devices (interpreted as "forwarding a received short message from the telephone 10 to another device or telephone" see [0029]);

a server function for identifying the preferred device in response to receiving the SMS message [0033], the preferred device being different than the second device (two different devices); and

a SMS server for sending the SMS message to the preferred device ([0033]-[0035]), the SMS server being further configured to format the SMS message in accordance with characteristics of the preferred device before sending the message to the preferred device ([0008]-[0010] and [0028]-[0040]).

But, Karve does not particularly show instead of the second device for receiving the SMS message. However in analogous art, Packham teaches instead of the second for receiving the SMS message (fig. 1 and [0019]-[0022]). Since, Karve and Packham



Art Unit: 2617

are related to a method for transmitting SMS message in a communication system; therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Karve as taught by Packham in order to allow the user to "turn their mobile phone(s) off in areas where that is necessary (such as in testing environments or hospitals) and still be able to have access to their messages. It also allows people to read their text messages received via email, for example on a home computer, which would possibly cause less disruption to their working day" see [0019]-[0022).

Regarding claim 10, Karve further discloses the apparatus of claim 9, wherein the SMS server is further configured to store messages to a database when the preferred device is not available to receive messages ([0028]-[0029] and [0007]).

Regarding claim 12, Karve discloses an apparatus for providing SMS messages to a user (owner of telephone 10, [0029]) associated, able to communicate, with a plurality of devices (interpreted as "forwarding a received short message from the telephone 10 to another device or telephone" see [0029]), comprising:

means for storing a specification of a preferred device ("a predefined number" [0032]-[0035]);

means for receiving a SMS message identifying one device ("telephone 10", see [0029]) of the plurality of devices [0028];

means for selecting the preferred device in response to receiving the SMS message ([0027]-[0035]), the preferred device being different than the identified one device (two different devices); and

means for sending the SMS message to the preferred device ([0032]-[0035]), the means for sending the SMS message comprises means for formatting the SMS message in accordance with characteristics of the preferred device before sending the message to the preferred device ([0008]-[0010] and [0028]-[0040]).

But, Karve does not particularly show instead of the identified one device for receiving the SMS message. However in analogous art, Packham teaches instead of the identified one device for receiving the SMS message (fig. 1 and [0019]-[0022]). Since, Karve and Packham are related to a method for transmitting SMS message in a communication system; therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Karve as taught by Packham in order to allow the user to "turn their mobile phone(s) off in areas where that is necessary (such as in testing environments or hospitals) and still be able to have access to their messages. It also allows people to read their text messages received via email, for example on a home computer, which would possibly cause less disruption to their working day" see [0019]-[0022).

Regarding claim 13, Karve further discloses the apparatus of claim 12, wherein the means for sending the SMS message comprises means for storing messages to a

database when the preferred device is not available to receive messages ([0028]-[0029] and [0007]).

Regarding claim 16, Karve discloses a method (fig. 3 and its description), comprising:

receiving a SMS message [0028] including information identifying a first destination device ("telephone 10", see [0029]);

identifying a second destination device ("a predefined number" [0032]-[0035]) in response to receiving the SMS message, the second destination device being different than the first destination device (two different devices);

formatting the SMS message based on the second destination device [0028];  
and

sending the formatted SMS message to the second destination device ([0032]-[0035]).

But, Karve does not particularly show instead of the first destination device for receiving the SMS message. However in analogous art, Packham teaches instead of the first destination device for receiving the SMS message (fig. 1 and [0019]-[0022]). Since, Karve and Packham are related to a method for transmitting SMS message in a communication system; therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Karve as taught by Packham in order to allow the user to "turn their mobile phone(s) off in areas where that is necessary (such as in testing environments or hospitals) and still be able to have

Art Unit: 2617

access to their messages. It also allows people to read their text messages received via email, for example on a home computer, which would possibly cause less disruption to their working day" see [0019]-[0022).

Regarding claim 17, Karve further discloses the method of claim 16 wherein the first destination device and the second destination device (interpreted as "forwarding a received short message from the telephone 10 to another device or telephone" see [0029]) are associated, able to communicate, with a receiving party (owner of telephone 10, [0029]), and wherein the identifying includes: identifying the second destination device based on a profile associated with receiving party ([0032]-[0033]).

II) Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Karve in view of Packham and further in view of Gopinath (US-2004/0002350).

Regarding claim 3, Karve and Packham discloses the method of claim 1. Both Karve ([0008]) and Packham ([0022]) suggest sending the formatted message to a personal computer and the user is able to retrieve the message. But Karve and Packham do not particularly teach wherein sending the formatted message comprises sending the formatted message to an e-mail address. However in analogous art, Gopinath teaches wherein sending the formatted message comprises sending the formatted message to an e-mail address ([0054]-[0069]). Since, Karve, Packham and Gopinath are related to a method for transmitting SMS message in a communication system; therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to modify the system of Karve and Packham as taught by Gopinath for purpose of incorporating the internet system with the SMS message system for increasing advantageously the communication services to the users.

III) Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Karve in view of Packham and further in view of Dehlin (US-2004/0203942; previously cited).

Regarding claim 4, Karve and Packham disclose the method of claim 1 except wherein sending the formatted message comprises sending the formatted message to an instant messenger client. However in analogous art, Dehlin teaches wherein sending the formatted message comprises sending the formatted message to an instant messenger client (described as "The reply customized SMS message is translated into a reply instant message" or "SMS message has been identified as an instant message type" see abstract and [0031]). Since Karve, Packham and Dehlin are related to a method for transmitting SMS message in a communication system; therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Karve and Packham as taught by Dehlin for purpose of "enabling instant messaging on a mobile device" (see Dehlin's title and specification).

IV) Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Karve in view of Sabo (US-2003/0096626; previously cited).

Regarding claim 5, Karve and Packham disclose the method of claim 1 except wherein sending the formatted message comprises sending the formatted message as

Art Unit: 2617

a voice message to a phone. However in analogous art, Sabo teaches wherein sending the formatted message comprises sending the formatted message as a voice message to a phone (described as "SMSC 18 translates the secure SMS message to a voice message, using a text-to-speech translator 24 comprised in the SMSC, and transmits text message 38 as a voice message 40" see [0031]. Since Karve, Packham and Sabo are related to a method for transmitting SMS message in a communication system; therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Karve and Packham as taught by Sabo for purpose of "in the case of the landline telephone, the translation is preferably to speech in a text-to-speech converter associated with the SMSC" (see Sabo's specification, para. [0013]).

V) Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Karve in view of Packham and further in view of Fostick (US-2002/0187794).

Regarding claim 7, Karve further discloses the method of claim 1 that once the mobile device receives a SMS message, which can be immediately displayed on the display of the mobile device. In either case, the message is stored for when the user desires to read the message. But Karve and Packham do not particularly teach storing messages in a database when the preferred device is not available to receive messages. However in analogous art, Fostick teaches wherein storing messages in a database when the device is not available to receive messages [0007]. Since, Karve, Packham and Fostick are related to a method for transmitting SMS message in a

Art Unit: 2617

communication system; therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Karve and Packham as taught by Fostick for purpose of guaranteeing the message delivery.

### ***Conclusion***

#### **4. THIS ACTION IS MADE FINAL.**

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

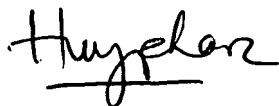
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huy Q Phan whose telephone number is 571-272-7924. The examiner can normally be reached on 8AM-6PM.

Art Unit: 2617

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on 571-272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



GEORGE ENG  
SUPERVISORY PATENT EXAMINER

Examiner: Phan, Huy Q.

AU: 2617

Date: 08/05/2007